

and 4, the protective device 7 of Frick appears to be integral part of the printer, and the device is secured by means 6 to the cover or housing 5. With respect to claim 6, the hood of Frick having an angle top portion at the numeral reference 10 in Fig. 1. of Frick. with respect to claims 8, and 9, the selection of a desired material which is transparent or dishwasher safe involves only an obvious matter of design choice based upon obvious experimentation." (emphasis added)

The standard to establish obviousness under 35 U.S.C. 103 has been defined by the CCPA and the CAFC to require: One or more references that were available to the inventor and that teach a suggestion to combine or modify the references, the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art. This standard has been set forth in numerous cases, including *W.L. Gore & Associates, Inc. V. Garlock, Inc.*, 220 USPSQ 303, 312-13 (Fed. Cir. 1983) *cert. denied*, 469 U.S. 851 (1984); *In re Fritch*, 23 USPQ 2d 1780, 1784 (Fed. Cir. 1992); and many others.

Thus, the Examiner must provide an (1) actual teaching that (2) suggests modifying the "protective device" of Frick and/or Otsubo (3) that would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art.

The Office Action acknowledged that neither reference taught or suggested the protective device (for) airborne particles. Instead, the Office Action merely states that "one of ordinary skill in the art would have used the protective device which reduces noise of Frick or Otsubo (soundproof protective device) for protecting dispensing devices or printers from airborne particles or dust or environmental contamination". The Office Action failed to provide the actual teaching or suggestion required by the CAFC to suggest using the soundproofing features of Frick or Otsubo to protect the printer from environmental contamination. Neither Frick or Otsubo is the least concerned with environmental contamination. There is simply no suggestion or teaching in Frick or Otsubo to modify their devices to prevent environmental contamination.

Frick discloses a sound insulating hood for noise emitting apparatus. This hood utilizes one or more sound insulating layers to lower the sound level outside the hood. There simply is no suggestion or teaching in this reference to protect the printer from anything. The sole purpose of the apparatus disclosed in this reference is to minimize sound transmissions.

Otsubo discloses a sound-proof case for packing printers. The entire purpose of this product is to improve a soundproof effect. There is no discussion, suggestion, or teaching of protecting the printer from airborne particles or any other type of contamination.

The Examiner, in the response to Applicant's prior arguments, dismissed the Applicant's arguments that Frick and Otsubo fail to disclose the claimed invention. The Examiner stated that "While the protective cover of Frick is used for reducing noise from the printer, one of ordinary skill in the art would have been reconzied that it protects the printer fro dust or environmental contamination." 35 U.S.C. 103 requires that there be an actual teaching that suggests modifying the structure of Frick or Otsubo in order to render the claimed invention obvious. The Examiner is not allowed to engage in impermissible hindsight in order to form that suggestion. This was clearly set forth in numerous cases, including *W.L. Gore & Associates, Inc. V. Garlock, Inc.*, 220 USPSQ 303, 312-13 (Fed. Cir. 1983) *cert. denied*, 469 U.S. 851 (1984).

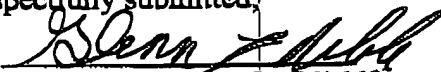
Thus, claims 1-4, 6 and 8 - 10 cannot be obvious under 35 U.S.C. 103 in view of Frick and Otsubo. The Applicant respectfully requests the Examiner to reconsider the earlier rejections and indicate these claims as allowable. The Examiner is respectfully requested to telephone the undersigned if further discussion would advance the prosecution of this application.

Date:

8/27/2001

Respectfully submitted,

By:



Glenn L. Webb, Reg. No. 32,668

P.O. Box 951

Conifer, CO 80433

(303) 838-8610